



FEE TRANSMITTAL for FY 2004

Effective 10/01/2004. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT (\$) 330.00

Complete if Known

Application Number 09/285,934
Filing Date April 2, 1999
First Named Inventor Randy Ubillos
Examiner Name Cao H. Nguyen
Art Unit 2173
Attorney Docket No. 4860P2292

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☒ None
☒ Deposit Account

Deposit Account Number

02-2666

Deposit Account Name

Blakely, Sokoloff, Taylor & Zafman LLP

The Commissioner is authorized to: (check all that apply)

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FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					

2. EXTRA CLAIM FEES

Total Claims	Extra Claims	Fee from below	Fee Paid
39	39*	0	\$0.00
Independent Claims	4	0	\$0.00
Multiple Dependent			

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	86	2201	43	Independent claims in excess of 3	
1203	290	2203	145	Multiple Dependent claim, if not paid	
1204	86	2204	43	**Reissue independent claims over original patent	
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)					0.00

*or number previously paid, if greater, For Reissues, see below

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
2053	130	2053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920 *	1804	920 *	Requesting publication of SIR prior to Examiner action	
1805	1,840 *	1805	1,840 *	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1404	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	330.00
1403	290	2403	145	Request for oral hearing	
1451	1,510	2451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	2460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	1809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify)					
* Reduced by Basic Filing Fee Paid					
SUBTOTAL (3)					330.00

SUBMITTED BY

Complete (if applicable)

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Date

07/21/04



TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application No.	09/285,934
Filing Date	April 2, 1999
First Named Inventor	Randy Ubillos
Art Unit	2173
Examiner Name	Cao H. Nguyen
Attorney Docket Number	4860P2292
Total Number of Pages in This Submission	80

ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to Group
<input checked="" type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Response	<input type="checkbox"/> Petition	<input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	-Check in the amount of \$330
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s)	-Return Receipt Postcard
<input type="checkbox"/> PTO/SB/08		
<input type="checkbox"/> Certified Copy of Priority Document(s)		
<input type="checkbox"/> Response to Missing Parts/Incomplete Application		
<input type="checkbox"/> Basic Filing Fee		
<input type="checkbox"/> Declaration/POA		
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm - or Individual name	Jonathan S. Miller, Reg. No. 48,534 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Signature	
Date	July 21, 2004

CERTIFICATE OF MAILING/TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Typed or printed name	Lillian E. Rodriguez		
Signature		Date	July 21, 2004



Attorney's Docket No. 4860P2292

AP/2173

DPW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Randy Ubillos

Serial No. 09/285,934

Filed: April 2, 1999

For: EDIT TO TAPE

Examiner: Nguyen, Cao H.

Art Group: 4312

APPEAL BRIEF

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant, (hereinafter "Appellant") submits, in triplicate, the following Appeal Brief pursuant to 37 C.F.R. § 1.192 for consideration by the Board of Patent Appeals and Interferences. Appellant also submits herewith a check in the amount of \$320.00 to cover the cost of filing the opening brief as required by 37 C.F.R. § 1.17(f). Please charge any additional amount due or credit any overpayment to deposit Account No. 02-2666.

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I. REAL PARTY IN INTEREST

Randy Ubillos, the party named in the caption, assigned his rights to the invention disclosed in the subject application through an Assignment recorded on June 1, 1999 at reel and frame 009990/0730 to Apple Computer, Inc., 1 Infinite Loop, Cupertino, California 95014. Therefore, Apple Computer, Inc. is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this Appeal.

III. STATUS OF CLAIMS

Claims 1-39 are pending in the application. The Examiner has rejected claims 1-25, 29 and 31-39. Claims 25-28 and 30 are objected to for depending from rejected base claims. The status of claim 25 is uncertain as the Examiner has indicated that this claim is both rejected under 35 U.S.C. § 103 and contains allowable subject matter. Appellant appeals the rejection of claims 1-24, 29 and 31-39.

IV. STATUS OF AMENDMENTS

No amendments to the claims were submitted after the Final Office Action mailed February 23, 2004.

V. SUMMARY OF THE INVENTION

The embodiments of the invention provide a method and apparatus for recording edited media to a sequential storage device. Page 5, lines 2-3. The sequential storage device may be a video tape deck or a video camcorder. Page 8, lines 1-3. The edited media may be stored in a predetermined media such as "Black and Code" tape. Page 7, line 18- Page 8, line 3. The edited media may be a time based stream of information from a source media. Page 5, lines 3-4. The media may be edited using a three point edit. Page 10, lines 17-18. A three point edit is a method in which three edit points are selected between a source and a destination, including a start point and end point in the source media and a start point in the destination media. Page 10, line 18 – page 11, line 10.

The embodiments of the invention include a user interface where media clips may be loaded and displayed. Page 11, line 20 – page 12, line 10. A control panel may display a time line tracking the chronological sequence of edited media (i.e., the time based stream of information). Page 12, line 4-10. Edit pointers may be positioned on the time line to select the portion of the media to be transferred. Page 12, lines 6-10. A second control panel interfaces with the sequential storage device (e.g., video tape deck). Page 13, lines 4-12. Time code indicators may be used to indicate the positioning of the playhead of the sequential device for purposes of recording and retrieving data. Page 13, line 21- page 13, line 13. The second control panel also includes a group of icons representing operations to be performed on the sequential device. Page 15-22. Edited source material may be dragged onto one of the icons to initiate an operation using that data on the sequential device. Page 17, lines 1-9.

VI. ISSUES

The issues involved in this Appeal are as follows:

A. Are claims 1-24, 29 and 31-39 unpatentable under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,426,778 issued to Valdez, Jr. ("Valdez") in view of U.S. Patent No. 5,706,456 issued to Dwyer et al ("Dwyer")?

VII. GROUPING OF CLAIMS

All of the claims do not stand or fall together. Rather, Appellant contends that the claims can be divided into the following groups and each group is separately patentable:

Group I - Claims 1, 10, 16-18, 24 and 31

Group II - Claims 2, 11, 25 and 32

Group III - Claims 3 and 33

Group IV - Claims 4 and 34

Group V - Claims 5 and 35

Group VI - Claims 6 and 36

Group VII - Claims 7, 15, 29 and 37

Group VIII - Claims 8, 22 and 38

Group IX - Claims 9, 23 and 39

Group X - Claims 12 and 19

Group XI - Claims 13 and 20

Group XII - Claims 14 and 21

The basis for the separate patentability of the groups is set forth below.

VIII. ARGUMENT

The Examiner has rejected claims 1-24, 29 and 31-39 as unpatentable under 35 U.S.C. §103 over Valdez (U.S. Patent No. 6,426,778) in view of Dwyer (U.S. Patent No. 5,706,457).

A. Overview of the Prior Art

1. Overview of Valdez

Valdez teaches a system and method for synchronizing interactive elements with a video signal. See Abstract Valdez. The system includes an editing system that schedules transmission and appearance of the interactive elements. Valdez, col. 3, lines 56-59. The graphical user interface of the editor includes a time line for scheduling the interactive elements in relation to the overall presentation. Valdez, col. 4, lines 1-3. The display of the interactive elements with the overall presentation is accomplished by transmitting the interactive elements to be viewed at a predetermined time in relation to the transmission of the presentation. Valdez, col. 4, lines 14-21. The interactive elements may also be inserted into a video signal. Valdez, col. 4, lines 22-26. The presentation and interactive elements are stored and organized as composition media objects, which are sets of descriptive information for playing a set of constituent source media objects. Valdez, col. 7, lines 50-59. Source media objects are audio, video, text or other media organized as objects in an object oriented programming paradigm. Valdez, col. 7, lines 60 – col. 8, line 2.

Valdez does not teach storing edited media on a sequential storage device. Valdez does not teach icons that represent functions to be performed on a sequential storage device. Valdez does not teach 'black and coding' a sequential access medium. Valdez does not teach a three point edit method.

2. Overview of Dwyer

Dwyer teaches a system and method for archiving digital image files. Dwyer col. 1, lines 38-42. The system provides a set of icons to facilitate the archiving of digital image files. Dwyer col. 1, lines 53-58. The icons if selected by a user initiate the execution of a macro. Dwyer col. 1,

lines 58-62. The macros perform a transfer of digital image files from camera storage media and remote storage media to a local storage device or printer. Dwyer col. 2 lines 20-30.

Dwyer does not teach icons for use in modifying or moving video data. Dwyer does not teach a set of icons to perform functions on a sequential storage device to edit a time based stream.

B. Rejection of Group I Under 35 U.S.C. § 103 as Obvious over Valdez in View of Dwyer

To establish a *prima facie* case for obviousness it must be shown that the cited references teach or suggest each element of the claim. See *In Re Reinhart*, 189 U.S.P.Q. 143, 147 CCPA, 1976 ("'*prima facie*' case of obviousness is established where the teachings from the prior art itself would appear to have suggested the claimed subject matter"). Further, the Examiner must show that there is some suggestion or motivation either in the references themselves or the knowledge generally available to one of ordinary skill in the art to combine the reference teachings. See *In Re Vaeck*, 20 USPQ2, 1438, 1442 (Fed. Cir. 1991), See also, MPEP § 2143.

In regard to claim 1, the Examiner argues that Valdez teaches "transferring said edited time based stream to a sequential storage device using an icon" and cites col. 6, lines 5-40 and col. 7, lines 9-67, as well as col. 17, lines 33-64 to support this assertion. The Examiner provides no guidance as to how the discussion in these large cited sections of Valdez teach or suggest any element of claim 1. Rather, the Examiner makes a citation to a large portion of the reference and makes a conclusion that the elements of the claim are taught. Appellant believes this approach does not meet the Examiner's obligation to establish a *prima facie* case of obviousness, as the Examiner has not explained in any reasonable fashion how the elements of the claim are taught or suggested by the cited references.

Appellant has to the best of its ability reviewed the cited sections of Valdez and has been unable to discern any part therein that teaches or suggests these elements of claim 1. Rather, the cited sections in col. 6, lines 5-40 provides a general description of an editing system which manipulates media files that may include interactive elements where these

elements may be viewed using a viewer system. Appellant has not discerned any part of this cited section of Valdez that teaches the use of an icon, a sequential storage device, or transferring an edited time base stream to a sequential storage device using an icon. Cited section, col. 7, lines 9-67, describes an editing system for manipulating media objects and composition media objects. Composition media objects are descriptions of constituent media objects. Media objects are object-oriented representations of source material. See Valdez, col. 7, lines 56-67. Appellant has been unable to discern any part of the cited section of Valdez, col. 7, lines 9-67, that teaches or suggests a sequential storage device and icon for transferring an edited time based stream to a sequential storage device. Cited section, col. 17, lines 33-64, describe a graphical user interface where multimedia files are represented by icons. See Valdez col. 17, lines 25-29. These individual files may be organized into a multimedia story by using graphical user interface tools to place connecting lines between the icons. See Valdez col. 17, lines 30-32. Thus, the icons described by Valdez do not perform functions, such as transferring data, as claimed in claim 1. Rather, these icons represent files or objects.

The Appellant repeatedly requested that the Examiner provide an explanation of how the cited sections support the rejection. However, the Examiner has only made conclusory remarks about broad citation to the cited references.

Also, the Examiner admits on page 2 of Paper No. 15 that Valdez fails to explicitly teach "wherein said icon represents a function be performed on said sequential storage device." It appears contradictory to Appellant that the Examiner admits that Valdez fails to teach an icon to perform a function on a sequential storage device, yet at the same time maintains that Valdez teaches transferring a time based stream to a sequential storage device using an icon.

Further, the Examiner seeks to combine Dwyer with Valdez to teach these elements of claim 1. The Examiner cites the Abstract of Dwyer in col. 4, lines 50-67 to teach "wherein said icon represents a function to be performed on said sequential storage device." Dwyer relates to the movement and archiving of individual images. See Abstract, Dwyer. The Examiner's rejection based on a combination of Dwyer with Valdez fails to read the claim as a whole. Claim 1 recites an

icon used to transfer an edited time based stream to a sequential storage device where the icon represents a function to be performed on the sequential storage device. Thus, the claims read as a whole indicate that the icon is used in connection with an edited time based stream. The Examiner has not indicated and Appellant has been unable to discern any part of Dwyer that teaches or suggests an icon representing a function where that icon can be used to transfer an edited time based stream to a sequential storage device. The manipulation of individual images as taught by Dwyer is well known to those skilled in the art to be a separate task from manipulation of a time based stream as claimed in claim 1. Thus, the Examiner has failed to establish that Dwyer teaches or suggests an icon to be used in connection with a time based stream. Rather, Dwyer is wholly concerned with the use of icons in the context of individual images.

Further, the Examiner has failed to properly establish a motivation for combining Dwyer with Valdez. The Examiner argues that one of ordinary skill in the art would see that the icon system of Dwyer would be obvious to combine with Valdez to "allow images to be accessed randomly, and video can be easily manipulate into any desired sequence where is in media clip video editing system." The Examiner argues the combination would be obvious for this reason without providing any citation or explanation as to where in the cited references this suggestion is taught or any explanation as to how the cited references support the Examiner's reasoning. In fact, Valdez presents a system for manipulating media objects which are to be associated with a video signal to provide interactive elements that are to be displayed concurrently with the video. These media objects are object oriented objects and the components thereof such as images are accessible and manipulated through the object oriented interface. The image file manipulation system of Dwyer and the object oriented media objects of Valdez operate based on different paradigms and the Examiner has offered no argument based in the references to overcome this incompatibility. One of ordinary skill in the art would not think to combine the image archiving system of Dwyer which operates on simple files with the object oriented system of Valdez which operates on composition media objects and constituent media objects.

The combination of these two references requires a change in the fundamental operating principle of Valdez which operates in the object oriented paradigm to accommodate the flat file system paradigm of Dwyer. Thus, for the reasons set forth above, Dwyer cannot be combined with Valdez because it proposes a modification that would change the principle of operation of Valdez and thus the combination of these references is not sufficient to render the claims *prima facie* obvious. See *In Re Ratti*, 270, F.2d 810, 123, USPQ 349 (CCPA 1959) and MPEP § 2143.01.

In regard to claims 10, 24 and 31, these claims contain many of the same elements as independent claim 1. Specifically, these claims include the elements of a method or system related to an icon that represents a function to be performed on a sequential storage device and transferring an edited time based stream to the sequential storage device using the icon. Thus, for the reasons set forth above in regard to independent claim 1, claims 10, 24 and 31 are not obvious over Valdez in view of Dwyer.

In regard to claims 16-18, these claims depend from independent claim 10 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to independent claim 10, these claims are not obvious over Valdez in view of Dwyer.

Accordingly, it is requested that the obviousness rejection of claims 1, 10, 16-18, 24, and 31 be overturned.

C. Rejection of Group II Under 35 U.S.C § 103 as Obvious over Valdez in View of Dwyer

In regard to claims 2, 11, 25 and 32, these claims depend from independent claims 1, 10 and 31 and incorporate the limitations therein. Thus, at least for the reasons mentioned in regard to claims 1, 10 and 31, above in the arguments relating to Group I, these claims are not obvious over Valdez in view of Dwyer.

In addition, claims 2, 11, 25 and 32 are separately, patentable because they include the elements of a three point edit between a source media and a destination media The Examiner cites

two full columns as well as figures 4-8 of Valdez as teaching these elements of claims 2, 11, 25 and 32 without providing any explanation as to how the cited sections and figures of Valdez teach the elements of these claims. Appellant has reviewed the cited sections and figures and has been unable to discern any portion therein that teaches a three point editing between a source media and destination media. The cited sections of Valdez teach a system of organizing data into objected orient 'media objects.'

Dwyer does not cure the defects of Valdez. The Examiner has not indicated and the Appellant has not been able to discern any part of Dwyer that teaches a three point edit between a source and destination media. Appellant, requested that the Examiner provide an explanation of the rejection of these claims, but the Examiner did not provide any support or clarification of how the cited references teach each of the elements of these claims. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 2, 11, 25 and 32 over Valdez in view of Dwyer.

In addition, the Examiner explicitly states that claim 25 contains allowable subject matter on page 4 and 10 of paper nos. 13 and 15, respectively, and does not list claim 25 as rejected in the disposition of claims for paper no. 15. However, claim 25 is listed on page 4 of paper no. 15 as rejected. The Examiner's, statements that claim 25 contains allowable subject matter contradicts the rejection of claim 25, as well as, claims 2, 11 and 32, which contain many of the same elements.

The claims of Group II are separately patentable because they include additional elements that are not taught by the cited references. Accordingly, it is requested that the obviousness rejection of Group II be overturned.

D. Rejection of Group III Under 35 U.S.C § 103 as Obvious over Valdez in View of Dwyer

In regard to claims 3 and 33, these claims depend from independent claims 1 and 31 and incorporate the limitations therein. Thus, at least for the reasons mentioned in regard to claims 1

and 31 above in the arguments relating to Group I, these claims are not obvious over Valdez in view of Dwyer.

In addition, claims 3 and 33 are separately, patentable because they include the elements of transferring an edited time based stream to a portion of a window that includes an icon that has a default function that is performed on a sequential storage device. The Examiner cites col. 5, lines 3-57 Valdez as teaching these elements of claims 3 and 33 without providing any explanation as to how the cited sections and figures of Valdez teach the elements of these claims. Appellant has reviewed the cited sections and has been unable to discern any portion therein that teaches a moving an edited time based stream to a portion of a window that includes an icon that has a default function that is performed on a sequential storage device. The cited sections of Valdez teach a system that runs on a standard operating system and communication network Appellant has not discerned any part of the cited sections that teaches moving an edited time based stream to a portion of a window that includes an icon that has a default function that is performed on a sequential storage device.

Dwyer does not cure the defects of Valdez. The Examiner has not indicated and the Appellant has not been able to discern any part of Dwyer that teaches moving an edited time based stream to a portion of a window that includes an icon that has a default function that is performed on a sequential storage device. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 3 and 33 over Valdez in view of Dwyer.

The claims of Group III are separately patentable because they include additional elements that are not taught by the cited references. Accordingly, it is requested that the obviousness rejection of Group III be overturned.

E. Rejection of Group IV Under 35 U.S.C § 103 as Obvious over Valdez in View of Dwyer

In regard to claims 4 and 34, these claims depend from independent claims 1 and 31 and incorporate the limitations therein. Thus, at least for the reasons mentioned in regard to claims 1 and 31 above in the arguments relating to Group I, these claims are not obvious over Valdez in view of Dwyer.

In addition, claims 4 and 34 are separately, patentable because they include the elements of transferring an edited time based stream to an icon that has a default function that performs a function on a sequential device. The Examiner cites col. 6, lines 21-67 Valdez as teaching these elements of claims 4 and 34 without providing any explanation as to how the cited sections and figures of Valdez teach the elements of these claims. Appellant has reviewed the cited sections and has been unable to discern any portion therein that teaches transferring an edited time based stream to an icon that has a default function that performs a function on a sequential device. The cited section of Valdez teaches interactive elements may take the form of markup language documents and the types of networks Valdez may utilize. See Valdez, col. 6, lines 21-40.

Dwyer does not cure the defects of Valdez. The Examiner has not indicated and the Appellant has not been able to discern any part of Dwyer that teaches transferring an edited time based stream to an icon that has a default function that performs a function on a sequential device. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 4 and 34 over Valdez in view of Dwyer.

The claims of Group IV are separately patentable because they include additional elements that are not taught by the cited references. Accordingly, it is requested that the obviousness rejection of Group IV be overturned.

F. Rejection of Group V Under 35 U.S.C § 103 as Obvious over Valdez in View of Dwyer

In regard to claims 5 and 35, these claims depend from independent claims 1 and 31 and incorporate the limitations therein. Thus, at least for the reasons mentioned in regard to claims 1 and 31 above in the arguments relating to Group I, these claims are not obvious over Valdez in view of Dwyer.

In addition, claims 5 and 35 are separately, patentable because they include the elements of clicking an icon with a cursor control device and the icon performing a transfer function on a sequential device. The Examiner cites col. 19, lines 30-67 Valdez as teaching these elements of claims 5 and 35 without providing any explanation as to how the cited sections and figures of Valdez teach the elements of these claims. Appellant has reviewed the cited sections and has been unable to discern any portion therein that teaches clicking an icon with a cursor control device and the icon performing a transfer function on a sequential device. The cited section of Valdez teaches enhanced events in a timeline and creation of media elements. See Valdez, col. 19, lines 30 and 55.

Dwyer does not cure the defects of Valdez. The Examiner has not indicated and the Appellant has not been able to discern any part of Dwyer that teaches clicking an icon with a cursor control device and the icon performing a transfer function on a requested device. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 5 and 35 over Valdez in view of Dwyer.

The claims of Group V are separately patentable because they include additional elements that are not taught by the cited references. Accordingly, it is requested that the obviousness rejection of Group V be overturned.

G. Rejection of Groups VI and X-XII Under 35 U.S.C § 103 as Obvious over Valdez in View of Dwyer

In regard to claims 6 and 36, these claims depend from independent claims 1 and 31 and incorporate the limitations therein. Thus, at least for the reasons mentioned in regard to claims 1 and 31 above in the arguments relating to Group I, these claims are not obvious over Valdez in view of Dwyer.

In addition, claims 6 and 36 are separately patentable because they include the elements of a function that is one of an insert edit, an assembly edit, and a preview edit. The Examiner cites col. 20, lines 1-64 and col. 18, lines 25, 64 Valdez as teaching these elements of claims 5 and 35 without providing any explanation as to how the cited sections of Valdez teach the elements of these claims. Appellant has reviewed the cited sections and has been unable to discern any portion therein that teaches a function that is one of an insert edit, an assembly edit, and a preview edit. The cited section of Valdez teaches importing a media file into an editing system. See Valdez, col. 18, lines 32-64.

Dwyer does not cure the defects of Valdez. The Examiner has not indicated and the Appellant has not been able to discern any part of Dwyer that teaches a function that is one of an insert edit, an assembly edit, and a preview edit. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 6 and 36 over Valdez in view of Dwyer.

Further, the Examiner has indicated that claims 26-28 contain allowable subject matter. These claims have many of the same elements as claims 6 and 36. The Appellant has requested that the Examiner clarify this apparent contradiction. However, the Examiner has not addressed this issue in paper no. 15.

The claims of Group VI are separately patentable because they include additional elements that are not taught by the cited references. Accordingly, it is requested that the obviousness rejection of Group VI be overturned.

Groups X-XII include many of the same elements as the claims of Group VI, namely, the functions of insert editing (Group X), assembly editing (Group XI), and preview editing (Group XII). However, these claims separate out these elements into individual dependant claims, instead of a single claim including each element in a 'one of' construct. Thus, each of these Groups is separately patentable as they each include different elements that are not taught or suggested by Valdez in view of Dwyer for the reasons set for above in regard to Group VI. Accordingly, it is requested that the obviousness rejection of each of Groups X-XII be overturned.

H. Rejection of Group VII Under 35 U.S.C § 103 as Obvious over Valdez in View of Dwyer

In regard to claims 7, 15, 29 and 37, these claims depend from independent claims 1, 10 and 31 and incorporate the limitations therein. Thus, at least for the reasons mentioned in regard to claims 1 and 31 above in the arguments relating to Group I, these claims are not obvious over Valdez in view of Dwyer.

In addition, claims 7, 15, 29 and 37 are separately patentable because they include the elements of a black and code format tape. The Examiner cites Figures 3A-4 of Valdez as teaching these elements of claims 7, 15, 29 and 37 without providing any explanation as to how the cited figures of Valdez teach the elements of these claims. Appellant has reviewed the figures and has been unable to discern any portion therein that teaches a black and code format tape. The cited figures of Valdez teach an overview of the system architecture and object structure without any mention of a black and code format tape. See Valdez, Figures 3A, 3B and 4.

Dwyer does not cure the defects of Valdez. The Examiner has not indicated and the Appellant has not been able to discern any part of Dwyer that teaches a black and code format tape. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 7, 15, 29 and 37 over Valdez in view of Dwyer.

The claims of Group VII are separately patentable because they include additional elements that are not taught by the cited references. Accordingly, it is requested that the obviousness rejection of Group VII be overturned.

I. Rejection of Group VIII Under 35 U.S.C § 103 as Obvious over Valdez in View of Dwyer

In regard to claims 8, 22 and 38, these claims depend from independent claims 1, 10 and 31 and incorporate the limitations therein. Thus, at least for the reasons mentioned in regard to claims 1, 10 and 31 above in the arguments relating to Group I, these claims are not obvious over Valdez in view of Dwyer.

In addition, claims 8, 22 and 38 are separately patentable because they include the elements of using a timecode indicator to position a playhead of a sequential storage device. The Examiner cites col. 21, lines 1-67 and col. 12, lines 10-55 of Valdez as teaching these elements of claims 8, 22 and 38 without providing any explanation as to how the cited sections of Valdez teach the elements of these claims. Appellant has reviewed the cited sections and has been unable to discern any portion therein that teaches using a timecode indicator to position a playhead of a sequential storage device. The cited sections of Valdez teach a set of information that is tracked by a component object. See Valdez, col. 12 lines 5-13. This tracked information does not appear to include a timecode. The cited section does not appear to have any connection to positioning a playhead of a sequential device.

Dwyer does not cure the defects of Valdez. The Examiner has not indicated and the Appellant has not been able to discern any part of Dwyer that teaches using a timecode indicator to position a playhead of a sequential storage device. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 8, 22 and 38 over Valdez in view of Dwyer.

The claims of Group VIII are separately patentable because they include additional elements that are not taught by the cited references. Accordingly, it is requested that the obviousness rejection of Group VIII be overturned.

J. Rejection of Group IX Under 35 U.S.C § 103 as Obvious over Valdez in View of Dwyer

In regard to claims 9, 23 and 39, these claims depend from independent claims 1, 10 and 31 and incorporate the limitations therein. Thus, at least for the reasons mentioned in regard to claims 1 and 31 above in the arguments relating the Group I, these claims are not obvious over Valdez in view of Dwyer.

In addition, claims 9, 23 and 39 are separately patentable because they include the elements of using a mark in icon or mark out icon to position a playhead of a sequential device. The Examiner cites col. 21, lines 1-67, specifically col. 21, lines 14-52, Valdez, as teaching these elements of claims 9, 23 and 39 without providing any explanation as to how the cited sections of Valdez teach the elements of these claims. Appellant has reviewed the cited sections and figures and has been unable to discern any portion therein that teaches using a mark in icon or mark out icon to position a playhead of a sequential device. The cited section of Valdez teaches a system for creating a composition with interactive elements by selecting a set of pre-edited video sequences and assigning interactive elements to timelines associated with each clip. See Valdez, col. 21 lines 14-31. This assembly process relies on the use of objected orient media and composition objects and is not related to the use of marking icons for use in positioning a playhead of a sequential device. The cited section does not appear to have any connection to positioning a playhead of a sequential device.

Dwyer does not cure the defects of Valdez. The Examiner has not indicated and the Appellant has not been able to discern any part of Dwyer that teaches using a mark in icon or mark out icon to position a playhead of a sequential device. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 9, 23 and 39 over Valdez in view of Dwyer.

The claims of Group IX are separately patentable because they include additional elements that are not taught by the cited references. Accordingly, it is requested that the obviousness rejection of Group IX be overturned.

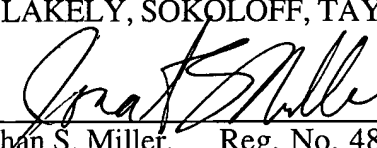
IX. CONCLUSION AND RELIEF

Accordingly, it is submitted that the rejections of Groups I-XII based on 35 U.S.C. § 103 be overturned.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

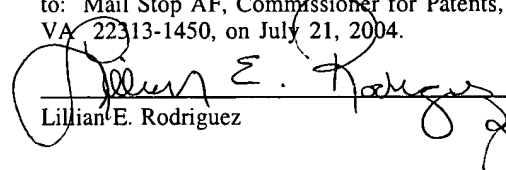
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CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Virginia, VA 22313-1450, on July 21, 2004.


Lillian E. Rodriguez

7-21-04
July 21, 2004

X. APPENDIX

The claims involved in this Appeal are as follows:

1. (Original) A method comprising:

displaying an indicia of a time based stream of information of a source media;

editing said time based stream using at least one edit point; and

transferring said edited time based stream to a sequential storage device using an icon, wherein said icon represents a function to be performed on said sequential storage device.

2. (Original) A method as in claim 1, wherein said editing comprises a three point editing between said source media and a destination media.

3. (Original) A method as in claim 1, wherein transferring said edited time based stream comprises:

transferring said edited time based stream to a portion of a window, said window having at least one icon;

said icon performing a function on said sequential device by default.

4. (Original) A method as in claim 1, wherein transferring said edited time based stream comprises:

transferring said edited time based stream to said icon, said icon performing said function on said sequential device.

5. (Original) A method as in claim 1, wherein transferring said edited time based stream comprises:

clicking said icon with a cursor control device, said icon performing said function on said sequential device.

6. (Original) A method as in claim 1, wherein said function is one of an insert edit, an assembly edit and a preview edit.

7. (Original) A method as in claim 1, further comprising:

black and coding a tape contained in said sequential device.

8. (Original) A method as in claim 1, further comprising:

using a timecode indicator to position a playhead of said sequential storage device.

9. (Original) A method as in claim 1, further comprising:

using one of a mark in icon and a mark out icon to position a playhead of said sequential storage device.

10. (Original) An apparatus comprising:

a display device to display an indicia of a time based stream of information of a source media;

means for editing said time based stream using at least one edit point;

at least one icon displayed on said display device, wherein said icon represents a function to be performed on a sequential storage device; and

means for transferring said edited time based stream to said sequential storage device using said icon.

11. (Original) An apparatus as in claim 10, wherein said editing means includes means for performing a three point editing between said source media and a destination media.

12. (Original) An apparatus as in claim 10, further comprising:
means for insert editing said edited time based stream to said sequential storage device using said icon.
13. (Original) An apparatus as in claim 10, further comprising:
means for assembly editing said edited time based stream to said sequential storage device using said icon.
14. (Original) An apparatus as in claim 10, further comprising:
means for preview editing said edited time based stream using said icon.
15. (Original) An apparatus as in claim 10, wherein said sequential device further comprising:
a tape having a black and code format.
16. (Original) An apparatus as in claim 10, further comprising:
means for positioning a playhead of said sequential storage device.
17. (Original) An apparatus as in claim 10, wherein said editing means is a cursor control device.
18. (Original) An apparatus as in claim 10, wherein said transferring means is a cursor control device.
19. (Original) An apparatus as in claim 12, wherein said insert editing means is a processor executing a sequence of instructions.

20. (Original) An apparatus as in claim 13, wherein said assembly editing means is a processor executing a sequence of instructions.

21. (Original) An apparatus as in claim 14, wherein said preview editing means is a processor executing a sequence of instructions.

22. (Original) An apparatus as in claim 16, wherein said positioning means is a timecode indicator.

23. (Original) An apparatus as in claim 16, wherein said positioning means is one of a mark in icon and a mark out icon.

24. (Original) A system comprising:
a computing device;
a display device to display an indicia of a time based stream of information of a source media;
at least one icon displayed on said display device, wherein said icon represents a function to be performed on a sequential storage device; and
said computing device including a first circuitry configured to edit said time based stream using at least one edit point, and
a second circuitry configured to transfer said edited time based stream to said sequential storage device using said icon.

25. (Original) A system as in claim 24, wherein said first circuitry includes a third circuitry configured to perform a three point editing between said source media and a destination media.

26. (Original) A system as in claim 24, further comprising:

a fourth circuitry configured to insert edit said edited time based stream to said sequential storage device using said icon.

27. (Original) A system as in claim 24, further comprising:

a fifth circuitry configured to assembly edit said edited time based stream to said sequential storage device using said icon.

28. (Original) A system as in claim 24, further comprising:

a sixth circuitry configured to preview edit said edited time based stream using said icon.

29. (Original) A system as in claim 24, wherein said sequential device further comprising:

a tape having a black and code format.

30. (Original) A system as in claim 24, further comprising:

a seventh circuitry configured to position a playhead of said sequential storage device.

31. (Original) A machine readable medium having stored thereon data representing sequences of instructions, which when executed by a computer system, cause said computer system to perform a method comprising:

displaying an indicia of a time based stream of information of a source media;

editing said time based stream using at least one edit point; and

transferring said edited time based stream to a sequential storage device using an icon,

wherein said icon represents a function to be performed on said sequential storage device.

32. (Original) A machine readable medium as in claim 32, wherein said editing comprises a three point editing between said source media and a destination media.

33. (Original) A machine readable medium as in claim 32, wherein transferring said edited time based stream comprises:

transferring said edited time based stream to a portion of a window, said window having at least one icon;

said icon performing a function on said sequential device by default.

34. (Original) A machine readable medium as in claim 32, wherein transferring said edited time based stream comprises:

transferring said edited time based stream to said icon, said icon performing said function on said sequential device.

35. (Original) A machine readable medium as in claim 32, wherein transferring said edited time based stream comprises:

clicking said icon with a cursor control device, said icon performing said function on said sequential device.

36. (Original) A machine readable medium as in claim 32, wherein said function is one of an insert edit, an assembly edit and a preview edit.

37. (Original) A machine readable medium as in claim 32, further comprising:
black and coding a tape contained in said sequential device.

38. (Original) A machine readable medium as in claim 32, further comprising:
using a timecode indicator to position a playhead of said sequential storage device.

39. (Original) A machine readable medium as in claim 32, further comprising:
using one of a mark in icon and a mark out icon to position a playhead of said sequential storage device.